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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,774	08/21/2001	Geoffrey R. Stanfield	MSFT-0581/167508.2	8593

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EXAMINER
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HARRIS, CHANDA L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/934,774

Applicant(s)

STANFIELD ET AL.

Examiner

Chanda L. Harris

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-30 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-13, 16, 19-21 is/are rejected.
- 7) ☒ Claim(s) 6-10, 14-15, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

In response to the amendment filed on 12/19/03, Claims 1-30 are pending.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Signals per se are not statutory subject matter. Signals have no tangible physical structure, do not perform any useful, concrete and tangible result, and do not constitute a tangible physical article or some form of matter. When a signal is coupled with or combined with a statutory physical structure to produce a useful, concrete and tangible result, the combination constitutes statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 11-13, 16, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romano et al. (US 5,991,595) in view of Robinson (US 2003/0031996).**

1. [Claims 1,3,16,21]: Regarding Claims 1,3,16, and 21, Romano discloses rendering definitional classification information (e.g. scoring guides, topic annotations, benchmark CRs, etc.) to the trainee to educate the trainee as to the nature of said at least one fundamental property. See Col.8: 47-51, 65-Col.9: 1. It is an inherent feature of Romano that the constructed responses would be scored according to some fundamental property, hence the use of the scoring guide by the raters. Romano discloses first assigning by at least one expert at least one expert-assigned value to said at least one fundamental property of the media entity (i.e. predetermined or qualified scores). See Col.13: 66-Col.14: 1. Romano discloses second assigning by said trainee at least one trainee-assigned value to said at least one fundamental property of the media entity (i.e. CR) after said rendering, said at least one trainee-assigned value equal in number to said at least one expert-assigned value (i.e. a rater passing the certification test). See Col.14: 1-11. Romano discloses comparing the at least one trainee-assigned value to the corresponding at least one expert-assigned value. See Col.13: 66-Col.14: 1. Romano discloses determining based on said comparing a first group (i.e. certification CRs) of said at least one fundamental property for which said trainee is qualified to code values for new media entities (e.g. from trainee to certified). See Col.12: 26-36 and Col.14: 11.

Romano discloses determining based on said comparing a second group of said at least one fundamental property for which said trainee is not qualified to code values for new media entities (i.e. not passing the test, cannot read and score production essays). See Col.9: 58-61 and Col.14: 9-11.

Romano discloses wherein said trainee is authorized to code new media entities for said first group of said at least one fundamental property (e.g. from trainee to certified, can read and score production essays). See Col.9: 60-61, Col.12: 29-31, and Col.14: 6-8.

Romano discloses a computing device (i.e. personal computer) comprising means for performing the method of Claim 1. See Col.7: 3-9.

Romano does not disclose expressly a plurality of fundamental properties. However, Robinson teaches assigning values corresponding to a plurality of fundamental properties (e.g., discourse subscore, rhetorical subscore). See pp.6-7, [0084]-[0086]. Therefore, at the time of the invention, it would have been obvious to incorporate a plurality of fundamental properties into the method and system of Romano, in light of the teaching of Robinson, in order to provide categorized assigning.

2. [Claim 2]: Regarding Claim 2, Romano discloses wherein said comparing includes comparing, value by value, the at least one trainee-assigned value to the corresponding at least one expert-assigned value. See Col.13: 66-Col.14: 1.

3. [Claim 4]: Regarding Claim 4, Romano discloses redoing the rendering, receiving, comparing and determining for fundamental properties of the second group until all properties in said second group are in said first group (i.e. passing a certification test,

can read and score production essays). See Col.9: 58-61.

4. [Claim 11]: Regarding Claim 11, Romano discloses wherein said rendering includes rendering said definitional classification information to the trainee via the Web (i.e. Internet). See Col.6: 49-58.

5. [Claim 12]: Regarding Claim 12, Romano discloses wherein said comparing includes performing statistical analysis (i.e. performance statistics) on said at least one trainee-assigned value and said at least one expert-assigned value (i.e. a score given by another rater). See Col.19: 16-29.

6. [Claim 13]: Regarding Claim 13, Romano discloses wherein said comparing includes calculating correlations between said at least one trainee-assigned value and said at least one expert-assigned value (e.g. the total number of essays with scores exactly equal to the score given by another rater). See Col.19: 16-29.

7. [Claim 19]: Regarding Claim 19, Romano discloses a computer readable medium (i.e. a suitable hard drive) bearing computer executable instructions for carrying out the method of Claim 1. See Col.7: 57-60.

8. [Claim 20]: Regarding Claim 20, Romano discloses a modulated data signal (i.e. means for communication) carrying computer executable instructions for performing the method of Claim 1. See Col.7: 61-63.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Romano.**

[Claim 5]: Regarding Claim 5, Romano does not disclose expressly wherein when all fundamental properties are in said first group, said trainee is a groover for all fundamental properties. However, Romano teaches the concept of being promoted to different statuses such as certified, experienced, or scoring leader. See Col.9: 47-48. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate promoting a trainee to a particular status into the method and system of Romano in order to indicate a level of knowledge attained.

***Allowable Subject Matter***

1. Claims 6-10, 14-15, 17-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claims 22-30 are allowed. The following is an examiner's statement of reasons for allowance: The prior art does not teach or fairly suggest means for receiving from a trainee classification data for classifying song segments and songs rendered by an audio rendering means and means for determining whether the trainee is qualified to

enter classification data for fundamental music properties (Claim 22 and similar language in independent claim 30).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Driscoll et al. (US 5,987,302)  
-instructional guidance as to how to improve writing skills

#### ***Response to Arguments***

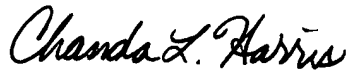
Applicant's arguments been considered but are moot in view of the new ground(s) of rejection regarding 35 USC 101). Therefore, this action is made NON-FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Chanda L. Harris  
Examiner  
Art Unit 3714

ch.